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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,880

07/10/2003

Benjamin David Silverman

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EXAMINER

NEGIN, RUSSELL SCOTT

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/616,880	<b>Applicant(s)</b> SILVERMAN, BENJAMIN DAVID	
	<b>Examiner</b> RUSSELL S. NEGIN	<b>Art Unit</b> 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1,3-5,7-9,14,15,17 and 19-21.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/Marjorie Moran/  
 Supervisory Patent Examiner, Art Unit 1631

Continuation of 3. NOTE: The individual computerized limitations of each step of the method claim 1, while overcoming the 35 USC 101 rejection if the amendment were entered, narrows that claimed embodiments from a general computer to perform the claimed algorithm to a method performed with a specific computer element for each step. Such a narrowing of the process by which each step of the claim is automated raises new grounds for search consideration as each of the specific elements recited must be assessed for prior art.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed 1 June 2009 have been fully considered but they are not persuasive.

Applicant first argues that Eisenberg et al. does not use a calculation of a first order moment. This is not persuasive because the abstract of Eisenberg et al. has the equation for a first order hydrophobic moment.

Applicant next argues that Eisenberg et al. does not show an enhanced correlation between residue centroid magnitude and residue solvent accessibility.

While applicant argues that the Examiner has changed opinions regarding Eisenberg et al. and this limitation, it is noted that this position (i.e. Eisenberg et al. does teach this correlation) is explained in the NON-FINAL Office action of 27 October 2008. Applicant contends, however, that Eisenberg et al. does not teach this limitation. In making arguments, applicant has taken Eisenberg et al. out of context. Specifically, the complete passage that applicant takes from Eisenberg et al. at the bottom of page 11 of the Remarks states, "The abscissa value of Fig. 2 reflects the solubility of each helix in a non-polar medium, the points falling to the right representing helices which prefer a non-polar medium to a polar medium. The ordinate reflects the tendency of a helix to assume a preferred orientation at an interface between polar and non-polar media." Consequently, as the ordinate access is correlated with the abscissa in Figure 2 of Eisenberg et al., and the abscissa pertains to solvent accessibility, the ordinate access is correlated with solvent accessibility.

Applicant additionally argues that Eisenberg et al. does not teach the limitation "wherein each residue centroid having a same fractional distance to a surface of the tertiary protein structure as one or more additional residue centroids contributed an equivalent magnitude to the global linear hydrophobic moment." This argument is not persuasive because there is no active step of calculating a fractional distance; the only requirement is that residue centroids HAVING the same fractional distance contribute an equivalent magnitude to the hydrophobic moment. Therefore, since none of the centroids have an exactly equal distance to the surface of the protein, there are no centroids that meet this limitation- consequently, this limitation of the independent claims is met by Eisenberg et al.

Applicants also argue that the amendments to the instant claims overcome the rejections of record. However, this argument is moot since the amendments are not entered.